

**REMARKS**

Claims 1-20, and 22-30 are pending with claims 27-30 added by this paper.

**Claim Amendments**

Applicants have amended claims 1, 3, 15 and 23 to replace either “of” or “is” with --which comprises--, --comprises--, or --comprising--. Also claims 19 and 22 are amended for clarification and to correct antecedent basis. Applicants respectfully submit that these amendments are made to further clarify that the absorber material can include other materials besides those specifically defined in the claim, and that these amendments do not narrow the scope of these claims.

**Claim Rejection Under 35 U.S.C. § 112, first paragraph**

Claim 1 allegedly stands rejected as failing to comply with the written description requirement. Particularly, the Action alleges that the disclosure fails to teach “irregular-shaped” particles or how to make a particle irregularly shaped. Applicants respectfully traverse these rejections.

The specification discloses micromilling polymers, such as thermoplastics, to create an absorber material. See, e.g., page 3, line 31 – page 4, line 17, and the Examples at pages 9-11. Applicants respectfully submit that the declaration filed November 14, 2001 establishes that the micromilled particles of the present invention have an irregular shape. Consequently, the irregular shape is an inherent property of the micromilled particles. Therefore, claiming such an inherent property does not create a violation with respect to written description. See, e.g., *In re Nathan et al.*, 328 F.2d 1005, 140 U.S.P.Q. 601 (CCPA 1964). Consequently, applicants respectfully submit that this ground of rejection should be withdrawn.

**New Claim 27**

Applicants have further defined the laser-markable polymer as an organic polymer (relevant to new claim 27). Support for this feature can be found throughout the specification, but particularly at page 4, lines 6-12, and the Examples at pages 9-11. Applicants respectfully submit that one of ordinary skill in the art would readily recognize that the claimed invention includes organic polymers because the preferred and exemplary polymers are all organic polymers. Consequently, applicants respectfully submit that there is support for this feature.

**Claim Rejection Under 35 U.S.C. § 112, second paragraph**

Claim 5 stands rejected as allegedly being indefinite for inclusion of the language “the particle structure of the markable polymer is retained in the plastic.” Applicants respectfully traverse this rejection.

Particularly, applicants respectfully submit that one of skill in the art can readily ascertain the metes and bounds of the rejected terminology. Particularly, one of skill in the art would readily recognize that the particles of the markable polymer are retained in the plastic by processes such as injection molding. See, e.g., page 6, lines 29-39. Consequently, applicants respectfully submit that this rejection should be withdrawn.

**Claim Rejections Under 35 U.S.C. § 102**

Claims 1-3, 6-7, 9-10, 12, 16-17, 19, 20 and 22-26 stand rejected as allegedly being anticipated by U.S. Patent No. 5,422,383 (Takahashi). Applicants respectfully traverse these rejections.

Takahashi discloses a thermosetting resin composition containing a resin and composite particles. The composite particles include a laser beam absorbing inorganic

substance (LB absorber) and a colorant. See column 2, lines 23-36. Different LB absorbers are disclosed at column 2, lines 40-42 and colorants are disclosed at column 3, lines 11-25. These composite particles are mixed with a resin to create an absorbing resin composition. See column 4, lines 8-22.

However, Takahashi fails to teach a laser-markable polymer (relevant to claim 1), or an absorber material comprising polyethylene terephthalate, acrylonitrile-butadiene-styrene copolymer, polystyrene, polyphenylene oxide, polyphenylene sulfide, polyphenylene sulfone, polyimidosulfone, a liquid crystal polymer or mixtures thereof (relevant to claim 15). Consequently, applicants respectfully submit that these rejections should be withdrawn.

#### **Double-Patenting Rejection**

Claims 1-26 stand rejected under the judicially created doctrine of obvious-type double-patenting as allegedly being unpatentable over claims 1-5, and 12-13 of U.S. Patent No. 5,928,780 (Schmidt) in view of WO 95/30716. Although the Action admits that the claimed particle size is not defined by Schmidt, the Action alleges that it would be obvious to one of ordinary skill in the art to make particles of such a size as taught by WO. Applicants respectfully traverse these rejections.

As admitted in the Action, Schmidt's claims fails to teach or suggest an absorber material comprising micromilled particles having a particle size of 0.1–100 microns. Applicants traverse the assertion that obtaining such a particle size is a matter of optimization, as allegedly illustrated by WO. Applicants note that Schmidt defines an additive containing a phyllosilicate. In marked contrast, WO discloses micropowders of polyphenylene ethers, polyarylene ether sulfones, polyether ketones, or polyimides. Applicants respectfully submit that these materials are not an obvious variant of a

phyllosilicate additive, and one of skill in the art would not select the teachings of WO to modify the particle size as claimed by Schmidt. Consequently, applicants respectfully submit that the claimed invention is not rendered obvious by the claims of Schmidt, and these rejections should be withdrawn.

**Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 1-26 stand rejected as allegedly being obvious over Schmidt in view of WO. Applicants attach herewith a Statement of Common Ownership disqualifying this rejection under 35 U.S.C. § 103(c). Consequently, applicants respectfully submit that this rejection should be withdrawn. Furthermore, applicants respectfully submit that disqualifying this reference in no way acquiesces to the merits of the rejections.

Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO in view EP 0367629 (EP). Applicants respectfully traverse these rejections.

At the outset, the Declaration submitted with Applicants' Supplemental Amendment and Reply filed November 14, 2001, provides evidence by one skilled in the art. Particularly, one of skill in the art attests that neither EP or WO disclose micromilled particles with an irregular surface for use as absorbers in plastics. Applicants respectfully submit that this evidence should be given full patentable weight.

In addition, the Declaration contained REM photographs which clearly show that the particles of the present invention are neither spherical nor smooth. In marked contrast, WO discloses a micropowder with particles having a "spherical and an essentially smooth surface" structure. See WO Abstract. Applicants respectfully submit that one of ordinary skill in the art would readily recognize that spherical or smooth particles as disclosed by WO are clearly distinct from the irregular-shaped particles of the present invention. Moreover, the

difference in shapes of the particles of the present invention versus the micropowder particles of WO are due to their different preparation processes. Particularly, WO discloses that the micropowder is prepared by spray-drying, whereas the particles of the present invention are prepared by micromilling of plastics. Thus, the irregular-shaped particles are a property of the particles themselves, in a way not disclosed by WO. Because there is no reason given in the Action why one of skill in the art would optimize by making the particles irregularly-shaped, particularly in view of the WO reference teaching a spherical or smooth shape, there is no motivation for one of skill in the art to make this modification.

In view of the above, favorable reconsideration is courteously requested. If there are any remaining issues which can be expedited by a telephone conference, the examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

James E. Ruland, Reg. No. 37,432  
Attorney for Applicants

MILLEN, WHITE, ZELANO &  
BRANIGAN, P.C.

Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2038

Date: December 18, 2003